



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,550	11/03/2003	Narasimha K. Nayak	08950.0003	9937

22852 7590 02/08/2006

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

CONTEE, JOY KIMBERLY

ART UNIT	PAPER NUMBER
----------	--------------

2686

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/698,550	NAYAK, NARASIMHA K.	
	Examiner	Art Unit	
	Joy K. Contee	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/18/05</u> . | 6) <input type="checkbox"/> Other: _____ |

67

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-34 have been considered but are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1,8 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Narayanan et al. (Narayanan), U.S. Patent No. 2004/0203385.

Regarding claims 1,8 and 24, Narayanan discloses a method for establishing communication between a first wireless terminal and a second wireless terminal, wherein the first wireless terminal may have at least one functional capability that the second wireless terminal may not have, the method comprising: receiving a signal from the first wireless terminal to establish a communication between the first wireless terminal and the second wireless terminal, wherein the communication includes use of the at least one functional capability that the second wireless terminal may not have; determining whether the second wireless terminal has the at least one functional

capability; and establishing the communication between the first wireless terminal and the second wireless terminal including use of the at least one functional capability, when it is determined that the second wireless terminal has the at least one functional capability (pages 1-3 [0015-018 & 0023-0030]).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-7,9-23 and 25-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narayanan, in view of Tabatabai et al. (Tabatabai), U.S. Patent Pub. No. 2003/0110297.

Regarding claim 2, Narayanan discloses the method of claim 1 but fails to further disclose what Tabatabai discloses comprising establishing the communication between the first wireless terminal and the second wireless terminal without the use of the at least one functional capability, when it is determined that the second wireless terminal does not have the at least one functional capability (pages 2-3, [0021-0027]).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Narayanan to include establishing communication between first and second wireless terminals when it is determined that the second terminal does not have at least one functional capability for the purpose of allowing for adaptation of multi-media data for communication between multiple target devices as taught in Tabatabai.

Regarding claim 3, Narayanan and Tabatabai discloses the method of claim 2, wherein the at least one functional capability includes at least one of video call capability and multimedia capability (see Tabatabai (pages 2-3, [0021-0027])).

Regarding claim 4, Narayanan and Tabatabai discloses the method of claim 2 further comprising: downgrading the communication between the first wireless terminal and the second wireless terminal to voice communication when it is determined that the second wireless terminal does not have the at least one functional capability (see Tabatabai (pages 2-3, [0021-0027])).

Regarding claim 5, Narayanan and Tabatabai discloses the method of claim 4 further comprising: downgrading the communication by splitting the communication into two streams (see Tabatabai (pages 2-3, [0021-0027])).

Regarding claim 6, Narayanan and Tabatabai discloses the method of claim 5, wherein the two streams comprise a voice only stream between the first wireless terminal and the second wireless terminal and a video stream between the first wireless terminal and a video server (see Tabatabai (pages 2-3, [0021-0027])).

Regarding claim 7, Narayanan and Tabatabai discloses the method of claim 5, further comprising forwarding the signal to a video gateway and setting up a video stream between the first wireless terminal and a video server (see Tabatabai (pages 2-3, [0021-0027])).

Regarding claim 9, Narayanan and Tabatabai discloses the system of claim 8, wherein the means for establishing communication between the first wireless terminal and the second wireless terminal establishes a communication between the first

wireless terminal and the second wireless terminal without the use of the at least one functional capability, when it is determined that the second wireless terminal does not have the at least one functional capability (see Tabatabai (pages 2-3, [0021-0027])).

Regarding claim 10, Narayanan and Tabatabai discloses the system of claim 9, wherein the at least one functional capability includes at least one of video call capability and multimedia capability (see Tabatabai (pages 2-3, [0021-0027])).

Regarding claim 11, Narayanan and Tabatabai discloses the system of claim 9 further comprising: means for downgrading the communication between the first wireless terminal and the second wireless terminal to voice communication when it is determined that the second wireless terminal does not have the at least one functional capability (see Tabatabai (pages 2-3, [0021-0027])).

Regarding claim 12, Narayanan and Tabatabai discloses the system of claim 11, wherein the means for downgrading the communication downgrades the communication by splitting the communication into two streams (see Tabatabai (pages 2-3, [0021-0027])).

Regarding claim 13, Narayanan and Tabatabai discloses the system of claim 12, wherein the two streams comprise a voice only stream between the first wireless terminal and the second wireless terminal and a video stream between the first wireless terminal and a video server (see Tabatabai (pages 2-3, [0021-0027])).

Regarding claim 14, Narayanan and Tabatabai discloses the system of claim 12 further comprising: means for forwarding the signal to a video gateway; and means for

setting up a video session between the first wireless terminal and a video server (see Tabatabai (pages 2-3, [0021-0027])).

Regarding claims 15, 18,21,33 and 34, Narayanan discloses a method for establishing communication between a first wireless terminal and a second wireless terminal, the method comprising: receiving a call signal from the first wireless terminal to establish a video session between the first wireless terminal and the second wireless terminal (page 2 [0016-0018]).

Narayanan fails to explicitly disclose querying a database to determine whether the second wireless terminal has video capability; if the second wireless terminal does not have video capability, then forwarding the call signal to a video gateway; setting up a video session between the first wireless terminal and a video server; and setting up a non-video session between the first wireless terminal and the second wireless terminal.

Tabatabai further discloses querying a database to determine whether the second wireless terminal has video capability; if the second wireless terminal does not have video capability, then forwarding the call signal to a video gateway; setting up a video session between the first wireless terminal and a video server; and setting up a non-video session between the first wireless terminal and the second wireless terminal (see Tabatabai (pages 2-3, [0021-0027])).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Narayanan to include establishing communication between first and second wireless terminals when it is determined that the second terminal does not have at least one functional capability for the purpose of allowing for adaptation of multi-

media data (e.g., non video data) for communication between multiple target devices as taught in Tabatabai.

Regarding claim 16, Narayanan and Tabatabai discloses the method of claim 15 further comprising the video server playing a video announcement for the first wireless terminal informing the first wireless terminal of a lack of the video capability in the second wireless terminal (see Tabatabai (pages 2-3, [0021-0027])).

Regarding claim 19, Narayanan and Tabatabai discloses the system of claim 18 further comprising means for playing a video announcement for the first wireless terminal informing the first wireless terminal of a lack of the video capability in the second wireless terminal (see Tabatabai (pages 2-3, [0021-0027])).

Regarding claim 21, Narayanan discloses a system for establishing communication between a first wireless terminal and a second wireless terminal, the system comprising: at least one mobile switching center for receiving a call signal from the first wireless terminal to establish at least one video session between the first wireless terminal and the second wireless terminal; at least one call processing module for querying at least one of a home location register and a visitor location register to determine whether the second wireless terminal has a video capability, for setting up at least one video session between the first wireless terminal and a video server, and for setting up at least one non-video session between the first wireless terminal and the second wireless terminal (col.1,line 54 to col. 2,line 9 and col.3,line 66 to col.4,line 25).

Regarding claim 23, Narayanan and Tabatabai discloses the system of claim 21, wherein the at least one call processing module is resident in a video gateway (see Tabatabai (pages 2-3, [0021-0027])).

Regarding claim 25, Narayanan and Tabatabai discloses the method of claim 24, wherein establishing the communication between the call originating terminal and the call receiving terminal further comprises establishing the call without the use of at least one call processing capability, when it is determined that the call receiving terminal does not have the at least one call processing capability (see Tabatabai (pages 2-3, [0021-0027])).

Regarding claim 26, Narayanan and Tabatabai discloses the method of claim 24, wherein establishing the communication between the call originating terminal and the call receiving terminal further comprises establishing the call without the use of at least one call processing capability, when it is determined that the call initially requires a call processing capability not available to the call receiving terminal (see Tabatabai (pages 2-3, [0021-0027])).

Regarding claim 27, Narayanan and Tabatabai discloses the method of claim 24, wherein establishing the communication between the call originating terminal and the call receiving terminal further comprises establishing the call without the use of video call capability, when the call originating terminal has video call capability, but the call receiving terminal does not have video call capability (see Tabatabai (pages 2-3, [0021-0027])).

Regarding claim 28, Narayanan and Tabatabai discloses the method of claim 25, wherein the at least one call processing capability includes at least one of video call capability and multimedia capability (see Tabatabai (pages 2-3, [0021-0027])).

Regarding claim 29, Narayanan and Tabatabai discloses the method of claim 25 further comprising: downgrading the communication between the call originating terminal and the call receiving terminal to voice communication when it is determined that the call receiving terminal does not have the at least one call processing capability (see Tabatabai (pages 2-3, [0021-0027])).

Regarding claim 30, Narayanan and Tabatabai discloses the method of claim 29 further comprising: downgrading the communication by splitting the communication into two streams (see Tabatabai (pages 2-3, [0021-0027])).

Regarding claim 31, Narayanan and Tabatabai discloses the method of claim 30, wherein the two streams comprise a voice only stream between the call originating terminal and the call receiving terminal and a video stream between the call originating terminal and a video server (see Tabatabai (pages 2-3, [0021-0027])).

Regarding claim 32, Narayanan and Tabatabai discloses the method of claim 30, further comprising forwarding the signal to a video gateway and setting up a video stream between the call originating terminal and a video server (see Tabatabai (pages 2-3, [0021-0027])).

6. Claims 17,20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narayanan and Tabatabai, in view of Gustafsson, U.S. Patent No. 6351,647.

Regarding claims 17,20 and 22, Narayanan and Tabatabai discloses the method of claims 15,18 and 21, respectively, but fails to disclose wherein the database is at least one of a home location register and a visitor location register and wherein the at least one call processing module is resident in the at least one mobile switching center.

In a similar field of endeavor, Gustafsson discloses wherein the database is at least one of a home location register and a visitor location register and wherein the at least one call processing module is resident in the at least one mobile switching center. (col. 2,lines 65 to col. 3,line 19).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Narayanan and Tabatabai include the HLR and VLR for the purpose of allowing information to be held in the wireless part of the network.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kalluri, US 2003/0054769 discloses a video recovery system and method.

Fjortoft et al., US Patent No. 6,542,521, discloses a method for improving service level selection in a communication network system.

Huff, US 2005/0165959, discloses a method and apparatus for performing wire speed auto-negotiation.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joy K. Contee whose telephone number is


Art Unit: 2686

571.272.7906. The examiner can normally be reached on Monday through Friday, 5:30 a.m. to 2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 571.272.7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JC


J. K. CONTEE
PATENT EXAMINER